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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------------|------------------|
| 09/634,171 | 08/09/2000 | Emanuel Israel Cooper | 13521(ARC9-2000-0067-US1) | 5758 |

7590 09/15/2003

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[REDACTED] EXAMINER

SHEEHAN, JOHN P

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1742

DATE MAILED: 09/15/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/634,171 | COOPER ET AL. |
| | Examiner | Art Unit |
| | John P. Sheehan | 1742 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
 - 2a) This action is FINAL. 2b) This action is non-final.
 - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-10 and 28-30 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) _____ is/are allowed.
 - 6) Claim(s) 1-10 and 28-30 is/are rejected.
 - 7) Claim(s) _____ is/are objected to.
 - 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 11, 2003 has been entered.

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 1742

3. Claims 1 to 10 and 28 to 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kakuno et al. (Kakuno, cited in the IDS submitted by the applicants on October 24, 2000).

Kakuno teaches specific examples alloys having compositions that are encompassed by the alloy composition recited in the instant claims (see Kakuno, page 3223, Figures 1 and 2; page 3224 Figure 3 and Table 1, Alloys 7 to 9). Kakuno teaches that these alloys are made by electroplating to a thickness of 0.3 μm (page 3222, right column, under the heading "Experimental", the first paragraph). Electroplating is the same process disclosed by applicants to make the instantly claimed alloy film. Further, Kakuno teaches electroplating using a current density of 10 to 50 mA/cm² (page 3223, left column, lines 1 to 5) which overlaps applicants' disclosed current density of 3 to 40 mA/cm² and applicants' preferred current density of 5 to 30 mA/cm² and completely encompasses applicants' most preferred current density of 10 to 20 mA/cm² (see instant specification, page 15, lines 25 to 32). Thus, Kakuno's alloys have compositions that are encompassed by the instant claims and are made by the same process as the claimed alloys, electroplating using current densities that encompass applicants' preferred current densities.

The claims and Kakuno differ in that Kakuno does not teach the following properties recited in the applicants' claims;

"being substantially free of oxygen and iron oxide"

"anisotropic" and

"having a saturation magnetization of at least about 2.3 Tesla"

Art Unit: 1742

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because in view of the fact, that Kakuno's alloys have compositions that are encompassed by the instant claims and are made by electroplating just as applicants' claimed alloys using current densities that encompass applicants' preferred current densities, Kakuno's alloys would be expected to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

— “Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977).” (emphasis added by the Examiner) see MPEP2112.01.

Further, with respect to the claim limitation, “being substantially free of oxygen and iron oxide”, (emphasis added by the Examiner) it is the Examiner’s position that use of the term “substantially” does not preclude the presence of some oxygen and iron oxide as taught by Kakuno (Page 3225, left column lines 1 to 3).

Response to Arguments

Applicant(s) arguments submitted July 17, 2003 have been considered but have been found non-persuasive.

Art Unit: 1742

Applicants argue that Kakuno does not teach an alloy "being substantially free of oxygen and iron oxide", "anisotropic" and "having a saturation magnetization of at least about 2.3 Tesla" and therefore the rejection under 35 USC 102 should be withdrawn and that "because there is not motivation in the applied reference which suggest modifying the disclosed deposits of the applied reference to include the various features recited in the claims of the present invention" the rejection under 35 USC 103 should be withdrawn.. The Examiner is not persuaded. In the statement of the rejection, although acknowledging that Kakuno is silent with respect to the anisotropy and the saturation magnetization of the disclosed film, the Examiner has set forth a sound basis why one of ordinary skill in the art would expect the specific example alloys would possess the same properties as recited in the instant claims. Under these circumstances a rejection under 35 USC 102/103 is appropriate and the burden shifts to applicants to show an unobvious difference (MPEP 2112). Applicants' arguments that Kakuno does not teach that the alloy is "anisotropic" and has 'a saturation magnetization of at least about 2.3 Tesla" and that "there is not motivation in the applied reference which suggest modifying the disclosed deposits of the applied reference to include the various features recited in the claims of the present invention" does not establish that there is an unobvious difference between Kakuno's alloy and the instant claimed alloy and therefore does meet applicants' burden.

Conclusion

4. This is a continuation of applicant's earlier Application No. 09/634,171. All claims are drawn to the same invention claimed in the earlier application and could have been

Art Unit: 1742

finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1742

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



John P. Sheehan
Primary Examiner
Art Unit 1742

jps

September 15, 2003